

**COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES & PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.136(a) (Small Entity)**

Docket No.

In Re Application Of: **JORASCH ET AL.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/597,801	June 20, 2000	Y. G. Cherubin	22927	3713	5985

Invention:

GAMING TOKEN HAVING A VARIABLE VALUE

COMMISSIONER FOR PATENTS:

This is a combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition under the provisions of 37 CFR 1.136(a) to extend the period for filing an Appeal Brief.

Applicant(s) hereby request(s) an extension of time of (check desired time period):

One month Two months Three months Four months Five months

The fee for the Appeal Brief and Extension of Time has been calculated as shown below:

Fee for Appeal Brief: \$250.00

Fee for Extension of Time: \$1,080.00

TOTAL FEE FOR APPEAL BRIEF AND EXTENSION OF TIME: \$1,330.00

The fee for the Appeal Brief and extension of time is to be paid as follows:

A check in the amount of \$ is enclosed for the Appeal Brief and copies.

- A check in the amount of _____ for the Appeal Brief and extension of time is enclosed.

Please charge Deposit Account No. **500271** in the amount of **\$1,330.00**

The Director is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. **500271**

Any additional filing fees required under 37 C.F.R. 1.16.

Any patent application processing fees under 37 CFR 1.17.

If an additional extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. **500271**.

Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

P34SMALL/REV04

**COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES & PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.136(a) (Small Entity)**

Docket No.
00-032

In Re Application Of: **JORASCH ET AL.**

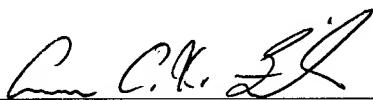
Application No. 09/597,801	Filing Date June 20, 2000	Examiner Y. G. Cherubin	Customer No. 22927	Group Art Unit 3713	Confirmation No. 5985
--------------------------------------	-------------------------------------	-----------------------------------	------------------------------	-------------------------------	---------------------------------

Invention:

GAMING TOKEN HAVING A VARIABLE VALUE

TO THE COMMISSIONER FOR PATENTS:

This combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition for extension of time under 37 CFR 1.136(a) is respectfully submitted by the undersigned:



Signature

Dated: **November 15, 2005**

Carson C. K. Fincham
Attorney for Applicants
PTO Registration No. 54,096
Walker Digital, LLC
203.461.7017/phone
203.461.7018/fax

Cfincham@walkerdigital.com

Certificate of Transmission by Facsimile*

I certify that this document and authorization to charge deposit account is being facsimile transmitted to the United States Patent and Trademark Office
(Fax no.) on

(Date)

Signature

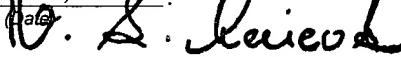
Typed or Printed Name of Person Signing Certificate

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a) on

November 15, 2005

Date



Signature of Person Mailing Correspondence

Veronika S. Leliever

Typed or Printed Name of Person Mailing Correspondence

*This certificate may only be used if paying by deposit account.

CC:

**COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES & PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.136(a) (Small Entity)**

Docket No.
00-032

In Re Application Of: JORASCH ET AL.

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/597,801	June 20, 2000	Y. G. Cherubin	22927	3713	5985

Invention:

GAMING TOKEN HAVING A VARIABLE VALUE

COMMISSIONER FOR PATENTS:

This is a combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition under the provisions of 37 CFR 1.136(a) to extend the period for filing an Appeal Brief.

Applicant(s) hereby request(s) an extension of time of (check desired time period):

<input type="checkbox"/> One month	<input type="checkbox"/> Two months	<input type="checkbox"/> Three months	<input type="checkbox"/> Four months	<input checked="" type="checkbox"/> Five months
from: _____	July 15, 2005	until: _____	November 15, 2005	
	<i>Date</i>		<i>Date</i>	

The fee for the Appeal Brief and Extension of Time has been calculated as shown below:

Fee for Appeal Brief: \$250.00

Fee for Extension of Time: \$1,080.00

TOTAL FEE FOR APPEAL BRIEF AND EXTENSION OF TIME: \$1,330.00

The fee for the Appeal Brief and extension of time is to be paid as follows:

- A check in the amount of _____ for the Appeal Brief and extension of time is enclosed.

Please charge Deposit Account No. **500271** in the amount of **\$1,330.00**

The Director is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. **500271**

Any additional filing fees required under 37 C.F.R. 1.16.

Any patent application processing fees under 37 CFR 1.17.

If an additional extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. **500271**

Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

**COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES & PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.136(a) (Small Entity)**

Docket No.
00-032

In Re Application Of: **JORASCH ET AL.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/597,801	June 20, 2000	Y. G. Cherubin	22927	3713	5985

Invention:

GAMING TOKEN HAVING A VARIABLE VALUE

TO THE COMMISSIONER FOR PATENTS:

This combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition for extension of time under 37 CFR 1.136(a) is respectfully submitted by the undersigned:



Signature

Dated: November 15, 2005

Carson C. K. Fincham
Attorney for Applicants
PTO Registration No. 54,096
Walker Digital, LLC
203.461.7017/phone
203.461.7018/fax

Cfincham@walkerdigital.com

Certificate of Transmission by Facsimile*

I certify that this document and authorization to charge deposit account is being facsimile transmitted to the United States Patent and Trademark Office
(Fax no.) on

(Date)

Signature

Typed or Printed Name of Person Signing Certificate

*This certificate may only be used if paying by deposit account.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a) on

November 15, 2005



Signature of Person Mailing Correspondence

Veronika S. Leliever

Typed or Printed Name of Person Mailing Correspondence

CC:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
CUSTOMER NO. 22927

Appellants: James A. Jorasch, Magdalena Mik, Scott Wolinsky, William P. Van Vooren, Nathaniel Levin, and Andrew P. Golden,
Application No.: 09/597,801
Filed: June 20, 2000
Title: GAMING TOKEN HAVING A VARIABLE VALUE

Attorney Docket No.: 00-032

Group Art Unit: 3713
Examiner: Yveste Gilberte Cherubin

APPEAL BRIEF

**BOARD OF PATENT APPEALS
AND INTERFERENCES**

Mail Stop: Appeal Brief
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Non-Final Office Action mailed January 13, 2005 (Part of Paper No. / Mail Date 122404), rejecting claims **6-9, 73-85, and 88-98.**

TABLE OF CONTENTS

REAL PARTY IN INTEREST	3
RELATED APPEALS AND INTERFERENCES.....	4
STATUS OF CLAIMS	5
STATUS OF AMENDMENTS	6
SUMMARY OF CLAIMED SUBJECT MATTER	7
1. Independent Claim 6	7
2. Independent Claim 8	8
3. Independent Claim 73	10
4. Independent Claim 79	11
5. Independent Claim 80	12
6. Independent Claim 81	13
7. Independent Claim 88	15
8. Independent Claim 92	17
9. Independent Claim 93	18
10. Independent Claim 95	19
11. Independent Claim 96	20
12. Independent Claim 98	21
GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	23
ARGUMENTS.....	25
1. Summary of Arguments	25
2. Form of Appeal Brief.....	26
3. 35 U.S.C. §112, second paragraph, Rejections	26
3.1. Claims 6-9, 73-85, and 88	27
4. 35 U.S.C. §103 Rejections	29
4.1. The Proper Legal Standard under 35 U.S.C. § 103(a)	30
4.2. Substantial evidence is required of all factual findings	32
4.3. Absent substantial evidence, no <i>prima facie</i> case exists.....	33
4.4. Claims 6, 8, 80, and 92-98	34
4.5. Claims 73 and 75-78	41
4.6. Claim 74.....	46
4.7. Claim 79.....	47
4.8. Claims 7, 9, 81-82, and 88	47
4.9. Claims 83-85 and 90-91	48
4.10. Claim 89.....	50
CONCLUSION.....	52
APPENDIX A - CLAIMS INVOLVED IN THE APPEAL	53
APPENDIX B – EVIDENCE.....	60
APPENDIX C – RELATED PROCEEDINGS.....	61

REAL PARTY IN INTEREST

The present application is assigned to Walker Digital, LLC, 5 High Ridge Park, Stamford, CT 06905.

RELATED APPEALS AND INTERFERENCES

No interferences or appeals are known to Appellants, Appellants' legal representative, or assignee that will directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims **6-9, 73-85, and 88-98** are pending in the present application.

Claims **1-5, 10-72, and 86-87** have been cancelled.

Claims **6-9, 73-85, and 88-98** are being appealed.

STATUS OF AMENDMENTS

No amendments were filed subsequent to the Non-Final Office Action mailed January 13, 2005, the rejections of which are being appealed herein.

SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the independent claims being appealed are provided below. The summaries include sufficient information about the claimed subject matter so that an informed review of the Examiner's adverse determination of patentability can be made.

As required by 37 C.F.R. § 41.37(c)(1)(v), reference is made to the Specification and Drawings, as appropriate. Any such reference:

- (i) is by way of example of the claimed subject matter only;
- (ii) is to be considered as potentially useful in clarifying the particular subject matter of the particular independent claim being explained (and not other claims or "the invention" as a whole), unless explicitly stated otherwise; and
- (iii) is not to be considered as broadening or narrowing the scope of any recited term from its meaning to one of ordinary skill in the art, unless explicitly stated otherwise.

Of the claims being appealed, claims **6, 8, 73, 79, 80-81, 88, 92-93, and 95-96**, and **98** are independent.

1. Independent Claim 6

In accordance with one or more embodiments, a method for changing a value of a gaming token provides for *associating a first non-zero value with a gaming token*. See, for example, Specification, pg. 8, line 23 to pg. 9, line 3; pg. 10, lines 23-27; pg. 20, lines 15-17; pg. 22, line 27 to pg. 23, line 4; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 32, lines 22-25; pg. 33, lines 5-8; FIG. 1, reference

numeral 102; FIG. 8 and FIG. 9; FIG. 11, reference numeral 1102; and FIG. 13 – FIG. 22.

The method further provides for *detecting an event*. See, for example, Specification, pg. 9, lines 5-22; pg. 10, lines 23-27; pg. 10, line 32 to pg. 11, line 3; pg. 17, lines 22-23; pg. 18, lines 23-24; pg. 20, lines 12-13; pg. 21, lines 13-17; pg. 21, lines 22-31; pg. 22, lines 1-8; pg. 23, lines 12 to pg. 24, line 32; pg. 27, lines 12-15; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 11-15; pg. 32, lines 16-18; pg. 36, lines 12-17; FIG. 1, reference numeral 104; FIG. 10; and FIG. 11, reference numeral 1106.

The method further provides for, *in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value, wherein the detected event is a period of time that a player has played a gaming device*. See, for example, Specification, pg. 9, lines 24-28; pg. 10, lines 23-27; pg. 17, lines 27-28; pg. 19, lines 8-14; pg. 20, lines 10-12; pg. 20, lines 20-23; pg. 21, lines 13-17; pg. 21, lines 29-31; pg. 22, lines 13-21; pg. 22, lines 23-25; pg. 24, line 24 to pg. 25, line 5; pg. 26, lines 11-20; pg. 27, lines 3-4; pg. 27, lines 12-15; pg. 27, lines 19-27; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 31, lines 6-8; pg. 32, lines 16-18; pg. 34, lines 4-6; pg. 34, lines 18-22; pg. 34, lines 30-32; pg. 36, lines 12-17; FIG. 1, reference numeral 106; FIG. 8 and FIG. 9; and FIG. 11, reference numeral 1108.

2. Independent Claim 8

In accordance with one or more embodiments, a method for changing a value of a gaming token provides for *associating a first non-zero value with a*

.gaming token. See, for example, Specification, pg. 8, line 23 to pg. 9, line 3; pg. 10, lines 23-27; pg. 20, lines 15-17; pg. 22, line 27 to pg. 23, line 4; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 32, lines 22-25; pg. 33, lines 5-8; FIG. 1, reference numeral 102; FIG. 8 and FIG. 9; FIG. 11, reference numeral 1102; and FIG. 13 – FIG. 22.

The method further provides for *detecting an event*. See, for example, Specification, pg. 9, lines 5-22; pg. 10, lines 23-27; pg. 10, line 32 to pg. 11, line 3; pg. 17, lines 22-23; pg. 18, lines 23-24; pg. 20, lines 12-13; pg. 21, lines 13-17; pg. 21, lines 22-31; pg. 22, lines 1-8; pg. 23, lines 12 to pg. 24, line 32; pg. 27, lines 12-15; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 11-15; pg. 32, lines 16-18; pg. 36, lines 12-17; FIG. 1, reference numeral 104; FIG. 10; and FIG. 11, reference numeral 1106.

The method further provides for, *in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value, wherein the detected event is a number of times that a player has played a gaming device.* See, for example, Specification, pg. 9, lines 24-28; pg. 10, lines 23-27; pg. 17, lines 27-28; pg. 19, lines 8-14; pg. 20, lines 10-12; pg. 20, lines 20-23; pg. 21, lines 13-17; pg. 21, lines 29-31; pg. 22, lines 13-21; pg. 22, lines 23-25; pg. 24, line 24 to pg. 25, line 5; pg. 26, lines 11-20; pg. 27, lines 3-4; pg. 27, lines 12-15; pg. 27, lines 19-27; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 31, lines 6-8; pg. 32, lines 16-18; pg. 34, lines 4-6; pg. 34, lines 18-22; pg. 34, lines 30-32; pg. 36, lines 12-17; FIG. 1, reference numeral 106; FIG. 8 and FIG. 9; and FIG. 11, reference numeral 1108.

3. Independent Claim 73

In accordance with one or more embodiments, a method for changing a value of a gaming token provides for *associating a first non-zero value with a gaming token*. See, for example, Specification, pg. 8, line 23 to pg. 9, line 3; pg. 10, lines 23-27; pg. 20, lines 15-17; pg. 22, line 27 to pg. 23, line 4; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 32, lines 22-25; pg. 33, lines 5-8; FIG. 1, reference numeral 102; FIG. 8 and FIG. 9; FIG. 11, reference numeral 1102; and FIG. 13 – FIG. 22.

The method further provides for *detecting an event*. See, for example, Specification, pg. 9, lines 5-22; pg. 10, lines 23-27; pg. 10, line 32 to pg. 11, line 3; pg. 17, lines 22-23; pg. 18, lines 23-24; pg. 20, lines 12-13; pg. 21, lines 13-17; pg. 21, lines 22-31; pg. 22, lines 1-8; pg. 23, lines 12 to pg. 24, line 32; pg. 27, lines 12-15; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 11-15; pg. 32, lines 16-18; pg. 36, lines 12-17; FIG. 1, reference numeral 104; FIG. 10; and FIG. 11, reference numeral 1106.

The method further provides for, *in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value, in which the gaming token includes a display device mounted in the gaming token, the display device being switchable between a first display status and a second display status different from the first display status*. See, for example, Specification, pg. 9, lines 24-28; pg. 10, lines 23-27; pg. 17, lines 27-28; pg. 19, lines 8-14; pg. 20, lines 10-12; pg. 20, lines 20-23; pg. 21, lines 13-17; pg. 21, lines 29-31; pg. 22, lines 13-21; pg. 22, lines 23-25; pg. 24, line 24 to pg. 25, line 5; pg. 26, lines 11-20; pg. 27, lines 3-4; pg. 27, lines 12-15; pg. 27, lines 19-27; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines

.6-8; pg. 29, lines 31-32; pg. 31, liens 6-8; pg. 32, lines 16-18; pg. 34, lines 4-6; pg. 34, lines 18-22; pg. 34, lines 30-32; pg. 36, lines 12-17; FIG. 1, reference numeral 106; FIG. 8 and FIG. 9; and FIG. 11, reference numeral 1108.

See also, Specification, pg. 2, lines 28-30; pg. 3, lines 1-12; pg. 3, lines 18-25; pg. 11, lines 18-20; pg. 11, lines 25-29; pg. 13, lines 22-23; pg. 21, lines 7-11; pg. 23, lines 6-8; pg. 25, liens 2-5; pg. 25, lines 11-23; pg. 27, line 19 to pg. 28, line 4; pg. 28, lines 17-27; pg. 29, lines 6-8; pg. 29, lines 20-23; pg. 29, line 31 to pg. 30, line 2; pg. 30, lines 14-18; pg. 32, lines 10-12; pg. 32, line 24 to pg. 35, line 28; pg. 36, lines 4-8; and pg. 36, lines 22-25.

4. Independent Claim 79

In accordance with one or more embodiments, a method for changing a value of a gaming token provides for *associating a first non-zero value with a gaming token*. See, for example, Specification, pg. 8, line 23 to pg. 9, line 3; pg. 10, lines 23-27; pg. 20, lines 15-17; pg. 22, line 27 to pg. 23, line 4; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 32, lines 22-25; pg. 33, lines 5-8; FIG. 1, reference numeral 102; FIG. 8 and FIG. 9; FIG. 11, reference numeral 1102; and FIG. 13 – FIG. 22.

The method further provides for *detecting an event*. See, for example, Specification, pg. 9, lines 5-22; pg. 10, lines 23-27; pg. 10, line 32 to pg. 11, line 3; pg. 17, lines 22-23; pg. 18, lines 23-24; pg. 20, lines 12-13; pg. 21, lines 13-17; pg. 21, lines 22-31; pg. 22, lines 1-8; pg. 23, lines 12 to pg. 24, line 32; pg. 27, lines 12-15; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 11-15; pg. 32, lines 16-18; pg. 36, lines 12-17; FIG. 1, reference numeral 104; FIG. 10; and FIG. 11, reference numeral 1106.

The method further provides for, *in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value, in which the gaming token includes a sound emitting device, mounted in the gaming token, for emitting at least one sound indicative of a status of the gaming token.* See, for example, Specification, pg. 9, lines 24-28; pg. 10, lines 23-27; pg. 17, lines 27-28; pg. 19, lines 8-14; pg. 20, lines 10-12; pg. 20, lines 20-23; pg. 21, lines 13-17; pg. 21, lines 29-31; pg. 22, lines 13-21; pg. 22, lines 23-25; pg. 24, line 24 to pg. 25, line 5; pg. 26, lines 11-20; pg. 27, lines 3-4; pg. 27, lines 12-15; pg. 27, lines 19-27; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 31, lines 6-8; pg. 32, lines 16-18; pg. 34, lines 4-6; pg. 34, lines 18-22; pg. 34, lines 30-32; pg. 36, lines 12-17; FIG. 1, reference numeral 106; FIG. 8 and FIG. 9; and FIG. 11, reference numeral 1108.

See also, Specification, pg. 3, lines 14-16; pg. 6, lines 4-6; pg. 11, lines 20-21; pg. 11, line 31 to pg. 12, line 6; pg. 12, lines 27-28; pg. 13, lines 25-27; and pg. 23, lines 8-10.

5. Independent Claim 80

In accordance with one or more embodiments, a method for changing a value of a gaming token provides for *associating a first non-zero value with a gaming token.* See, for example, Specification, pg. 8, line 23 to pg. 9, line 3; pg. 10, lines 23-27; pg. 20, lines 15-17; pg. 22, line 27 to pg. 23, line 4; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 32, lines 22-25; pg. 33, lines 5-8; FIG. 1, reference numeral 102; FIG. 8 and FIG. 9; FIG. 11, reference numeral 1102; and FIG. 13 – FIG. 22.

The method further provides for *detecting an event*. See, for example, Specification, pg. 9, lines 5-22; pg. 10, lines 23-27; pg. 10, line 32 to pg. 11, line 3; pg. 17, lines 22-23; pg. 18, lines 23-24; pg. 20, lines 12-13; pg. 21, lines 13-17; pg. 21, lines 22-31; pg. 22, lines 1-8; pg. 23, lines 12 to pg. 24, line 32; pg. 27, lines 12-15; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 11-15; pg. 32, lines 16-18; pg. 36, lines 12-17; FIG. 1, reference numeral 104; FIG. 10; and FIG. 11, reference numeral 1106.

The method further provides for, *in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value, wherein the detected event is cashing in of the gaming token*. See, for example, Specification, pg. 9, lines 24-28; pg. 10, lines 23-27; pg. 17, lines 27-28; pg. 19, lines 8-14; pg. 20, lines 10-12; pg. 20, lines 20-23; pg. 21, lines 13-17; pg. 21, lines 29-31; pg. 22, lines 13-21; pg. 22, lines 23-25; pg. 24, line 24 to pg. 25, line 5; pg. 26, lines 11-20; pg. 27, lines 3-4; pg. 27, lines 12-15; pg. 27, lines 19-27; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 31, lines 6-8; pg. 32, lines 16-18; pg. 34, lines 4-6; pg. 34, lines 18-22; pg. 34, lines 30-32; pg. 36, lines 12-17; FIG. 1, reference numeral 106; FIG. 8 and FIG. 9; and FIG. 11, reference numeral 1108.

6. Independent Claim 81

In accordance with one or more embodiments, a method for changing a value of a gaming token provides for *associating a first non-zero value with a gaming token*. See, for example, Specification, pg. 8, line 23 to pg. 9, line 3; pg. 10, lines 23-27; pg. 20, lines 15-17; pg. 22, line 27 to pg. 23, line 4; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 32, lines 22-25; pg. 33, lines 5-8; FIG. 1, reference

numeral 102; FIG. 8 and FIG. 9; FIG. 11, reference numeral 1102; and FIG. 13 – FIG. 22.

The method further provides for *detecting an event*. See, for example, Specification, pg. 9, lines 5-22; pg. 10, lines 23-27; pg. 10, line 32 to pg. 11, line 3; pg. 17, lines 22-23; pg. 18, lines 23-24; pg. 20, lines 12-13; pg. 21, lines 13-17; pg. 21, lines 22-31; pg. 22, lines 1-8; pg. 23, lines 12 to pg. 24, line 32; pg. 27, lines 12-15; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 11-15; pg. 32, lines 16-18; pg. 36, lines 12-17; FIG. 1, reference numeral 104; FIG. 10; and FIG. 11, reference numeral 1106.

The method further provides for, *in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value*. See, for example, Specification, pg. 9, lines 24-28; pg. 10, lines 23-27; pg. 17, lines 27-28; pg. 19, lines 8-14; pg. 20, lines 10-12; pg. 20, lines 20-23; pg. 21, lines 13-17; pg. 21, lines 29-31; pg. 22, lines 13-21; pg. 22, lines 23-25; pg. 24, line 24 to pg. 25, line 5; pg. 26, lines 11-20; pg. 27, lines 3-4; pg. 27, lines 12-15; pg. 27, lines 19-27; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 31, lines 6-8; pg. 32, lines 16-18; pg. 34, lines 4-6; pg. 34, lines 18-22; pg. 34, lines 30-32; pg. 36, lines 12-17; FIG. 1, reference numeral 106; FIG. 8 and FIG. 9; and FIG. 11, reference numeral 1108.

The method further provides for, *receiving the gaming token at a gaming device*. See, for example, Specification, pg. 2, lines 18-19; pg. 3, lines 28-29; pg. 4, lines 1-2; pg. 4, lines 12-13; pg. 4, lines 19-23; pg. 9, line 9; pg. 15, lines 30-32; pg. 17, lines 22-27; pg. 21, lines 17-20; pg. 23, lines 15-16; pg. 25, lines 8-11; pg. 26, lines 25-26; pg. 27, lines 8-10; pg. 27, lines 14-15; pg. 27, lines 23-24; pg. 28,

lines 20-21; pg. 28, lines 25-27; pg. 30, lines 20-22; pg. 31, lines 4-11; pg. 32, lines 3-6; pg. 32, lines 16-17; and FIG. 10, reference numeral 1006.

The method further provides for, *after said receiving step, reading from the gaming token a token identifier*. See, for example, Specification, pg. 4, lines 13-17; pg. 4, lines 23-25; pg. 4, line 27; pg. 17, lines 15-28; pg. 18, line 31 to pg. 19, line 6; pg. 19, lines 16-30; pg. 25, lines 13-15; pg. 25, lines 22-23; pg. 26, lines 26-32; pg. 30, line 22; pg. 31, lines 18-20; and pg. 32, lines 3-4.

The method further provides for, *determining on the basis of the read token identifier whether a prize has been won*. See, for example, Specification, pg. 4, lines 14-20; pg. 4, lines 27-30; pg. 30, lines 22-23;

The method further provides for, *displaying a result of the determining step*. See, for example, Specification, pg. 4, lines 29-30; and pg. 30, line 24.

7. Independent Claim 88

In accordance with one or more embodiments, a method for changing a value of a gaming token provides for *associating a first non-zero value with a gaming token*. See, for example, Specification, pg. 8, line 23 to pg. 9, line 3; pg. 10, lines 23-27; pg. 20, lines 15-17; pg. 22, line 27 to pg. 23, line 4; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 32, lines 22-25; pg. 33, lines 5-8; FIG. 1, reference numeral 102; FIG. 8 and FIG. 9; FIG. 11, reference numeral 1102; and FIG. 13 – FIG. 22.

The method further provides for *detecting an event*. See, for example, Specification, pg. 9, lines 5-22; pg. 10, lines 23-27; pg. 10, line 32 to pg. 11, line 3; pg. 17, lines 22-23; pg. 18, lines 23-24; pg. 20, lines 12-13; pg. 21, lines 13-17; pg. 21, lines 22-31; pg. 22, lines 1-8; pg. 23, lines 12 to pg. 24, line 32; pg. 27, lines 12-15; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 11-15; pg. 32, lines 16-

.18; pg. 36, lines 12-17; FIG. 1, reference numeral 104; FIG. 10; and FIG. 11, reference numeral 1106.

The method further provides for, *in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value, in which the gaming token includes a display.* See, for example, Specification, pg. 9, lines 24-28; pg. 10, lines 23-27; pg. 17, lines 27-28; pg. 19, lines 8-14; pg. 20, lines 10-12; pg. 20, lines 20-23; pg. 21, lines 13-17; pg. 21, lines 29-31; pg. 22, lines 13-21; pg. 22, lines 23-25; pg. 24, line 24 to pg. 25, line 5; pg. 26, lines 11-20; pg. 27, lines 3-4; pg. 27, lines 12-15; pg. 27, lines 19-27; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 31, lines 6-8; pg. 32, lines 16-18; pg. 34, lines 4-6; pg. 34, lines 18-22; pg. 34, lines 30-32; pg. 36, lines 12-17; FIG. 1, reference numeral 106; FIG. 8 and FIG. 9; and FIG. 11, reference numeral 1108.

See also, Specification, pg. 2, lines 28-30; pg. 3, lines 1-12; pg. 3, lines 18-25; pg. 11, lines 18-20; pg. 11, lines 25-29; pg. 13, lines 22-23; pg. 21, lines 7-11; pg. 23, lines 6-8; pg. 25, lines 2-5; pg. 25, lines 11-23; pg. 27, line 19 to pg. 28, line 4; pg. 28, lines 17-27; pg. 29, lines 6-8; pg. 29, lines 20-23; pg. 29, line 31 to pg. 30, line 2; pg. 30, lines 14-18; pg. 32, lines 10-12; pg. 32, line 24 to pg. 35, line 28; pg. 36, lines 4-8; and pg. 36, lines 22-25.

The method further provides for, *using the display to display information.* See, for example, Specification, pg. 2, lines 28-30; pg. 3, lines 1-12; pg. 3, lines 18-25; pg. 11, lines 18-20; pg. 11, lines 25-29; pg. 13, lines 22-23; pg. 21, lines 7-11; pg. 23, lines 6-8; pg. 25, lines 2-5; pg. 25, lines 11-23; pg. 27, line 19 to pg. 28, line 4; pg. 28, lines 17-27; pg. 29, lines 6-8; pg. 29, lines 20-23; pg. 29, line 31 to pg. 30, line 2; pg. 30, lines 14-18; pg. 32, lines 10-12; pg. 32, line 24 to pg. 35, line 28; pg. 36, lines 4-8; and pg. 36, lines 22-25.

The method further provides for, *determining an outcome of a game based on the displayed information*. See, for example, Specification, pg. 5, lines 3-5; pg. 21, lines 4-11; pg. 29, line 6 to pg. 30, line 18; and pg. 36, lines 22-25.

8. Independent Claim 92

In accordance with one or more embodiments, a method for changing a value of a gaming token provides for *associating a first non-zero value with a gaming token*. See, for example, Specification, pg. 8, line 23 to pg. 9, line 3; pg. 10, lines 23-27; pg. 20, lines 15-17; pg. 22, line 27 to pg. 23, line 4; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 32, lines 22-25; pg. 33, lines 5-8; FIG. 1, reference numeral 102; FIG. 8 and FIG. 9; FIG. 11, reference numeral 1102; and FIG. 13 – FIG. 22.

The method further provides for *detecting an event*. See, for example, Specification, pg. 9, lines 5-22; pg. 10, lines 23-27; pg. 10, line 32 to pg. 11, line 3; pg. 17, lines 22-23; pg. 18, lines 23-24; pg. 20, lines 12-13; pg. 21, lines 13-17; pg. 21, lines 22-31; pg. 22, lines 1-8; pg. 23, lines 12 to pg. 24, line 32; pg. 27, lines 12-15; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 11-15; pg. 32, lines 16-18; pg. 36, lines 12-17; FIG. 1, reference numeral 104; FIG. 10; and FIG. 11, reference numeral 1106.

The method further provides for, *in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value, wherein the detected event is insertion of the gaming token in a gaming device*. See, for example, Specification, pg. 9, lines 24-28; pg. 10, lines 23-27; pg. 17, lines 27-28; pg. 19, lines 8-14; pg. 20, lines 10-12; pg. 20, lines 20-23; pg. 21, lines 13-17; pg. 21, lines 29-31; pg. 22, lines 13-21; pg. 22, lines 23-25; pg. 24, line 24 to pg. 25, line 5; pg. 26, lines 11-

.20; pg. 27, lines 3-4; pg. 27, lines 12-15; pg. 27, lines 19-27; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 31, liens 6-8; pg. 32, lines 16-18; pg. 34, lines 4-6; pg. 34, lines 18-22; pg. 34, lines 30-32; pg. 36, lines 12-17; FIG. 1, reference numeral 106; FIG. 8 and FIG. 9; and FIG. 11, reference numeral 1108.

See also, Specification, pg. 2, lines 18-19; pg. 3, lines 28-29; pg. 4, lines 1-2; pg. 4, lines 12-13; pg. 4, lines 19-23; pg. 9, line 9; pg. 15, lines 30-32; pg. 17, lines 22-27; pg. 21, lines 17-20; pg. 23, lines 15-16; pg. 25, lines 8-11; pg. 26, lines 25-26; pg. 27, lines 8-10; pg. 27, lines 14-15; pg. 27, lines 23-24; pg. 28, lines 20-21; pg. 28, lines 25-27; pg. 30, lines 20-22; pg. 31, lines 4-11; pg. 32, lines 3-6; pg. 32, lines 16-17; and FIG. 10, reference numeral 1006.

9. Independent Claim 93

In accordance with one or more embodiments, a method for changing a value of a gaming token provides for *associating a first non-zero value with a gaming token*. See, for example, Specification, pg. 8, line 23 to pg. 9, line 3; pg. 10, lines 23-27; pg. 20, lines 15-17; pg. 22, line 27 to pg. 23, line 4; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 32, lines 22-25; pg. 33, lines 5-8; FIG. 1, reference numeral 102; FIG. 8 and FIG. 9; FIG. 11, reference numeral 1102; and FIG. 13 – FIG. 22.

The method further provides for *determining that a player has played at least a predetermined number of plays of a game*. See, for example, Specification, pg. 2, lines 21-22; pg. 9, lines 15-18; pg. 23, lines 19-25; pg. 27, lines 19-22; pg. 28, lines 6-8; pg. 28, line 31; pg. 29, lines 10-15; and FIG. 10, reference numeral 1008.

The method further provides for, *in response to determining that the player has played at least a predetermined number of plays of the game, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value.* See, for example, Specification, pg. 9, lines 24-28; pg. 10, lines 23-27; pg. 17, lines 27-28; pg. 19, lines 8-14; pg. 20, lines 10-12; pg. 20, lines 20-23; pg. 21, lines 13-17; pg. 21, lines 29-31; pg. 22, lines 13-21; pg. 22, lines 23-25; pg. 24, line 24 to pg. 25, line 5; pg. 26, lines 11-20; pg. 27, lines 3-4; pg. 27, lines 12-15; pg. 27, lines 19-27; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 31, lines 6-8; pg. 32, lines 16-18; pg. 34, lines 4-6; pg. 34, lines 18-22; pg. 34, lines 30-32; pg. 36, lines 12-17; FIG. 1, reference numeral 106; FIG. 8 and FIG. 9; and FIG. 11, reference numeral 1108.

10. Independent Claim 95

In accordance with one or more embodiments, a method for changing a value of a gaming token provides for *associating a first non-zero value with a gaming token.* See, for example, Specification, pg. 8, line 23 to pg. 9, line 3; pg. 10, lines 23-27; pg. 20, lines 15-17; pg. 22, line 27 to pg. 23, line 4; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 32, lines 22-25; pg. 33, lines 5-8; FIG. 1, reference numeral 102; FIG. 8 and FIG. 9; FIG. 11, reference numeral 1102; and FIG. 13 – FIG. 22.

The method further provides for *determining that a player has played a game for a predetermined period of time.* See, for example, Specification, pg. 2, lines 20-21; pg. 9, lines 12-15; pg. 23, lines 22-23; pg. 27, lines 19-22; pg. 28, lines 6-8; pg. 28, lines 30-31; pg. 29, lines 10-15; and FIG. 10, reference numeral 1010.

The method further provides for, *in response to determining that the player has played the game for a predetermined period of time, associating a second non-*

zero value with the gaming token, the second non-zero value being different from the first non-zero value. See, for example, Specification, pg. 9, lines 24-28; pg. 10, lines 23-27; pg. 17, lines 27-28; pg. 19, lines 8-14; pg. 20, lines 10-12; pg. 20, lines 20-23; pg. 21, lines 13-17; pg. 21, lines 29-31; pg. 22, lines 13-21; pg. 22, lines 23-25; pg. 24, line 24 to pg. 25, line 5; pg. 26, lines 11-20; pg. 27, lines 3-4; pg. 27, lines 12-15; pg. 27, lines 19-27; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 31, lines 6-8; pg. 32, lines 16-18; pg. 34, lines 4-6; pg. 34, lines 18-22; pg. 34, lines 30-32; pg. 36, lines 12-17; FIG. 1, reference numeral 106; FIG. 8 and FIG. 9; and FIG. 11, reference numeral 1108.

11. Independent Claim 96

In accordance with one or more embodiments, a method for changing a value of a gaming token provides for *associating a first non-zero value with a gaming token.* See, for example, Specification, pg. 8, line 23 to pg. 9, line 3; pg. 10, lines 23-27; pg. 20, lines 15-17; pg. 22, line 27 to pg. 23, line 4; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 32, lines 22-25; pg. 33, lines 5-8; FIG. 1, reference numeral 102; FIG. 8 and FIG. 9; FIG. 11, reference numeral 1102; and FIG. 13 – FIG. 22.

The method further provides for *determining that a player has achieved a predetermined rank of hand at least two times.* See, for example, Specification, pg. 23, lines 26-29.

The method further provides for, *in response to determining that the player has achieved the predetermined rank of hand at least two times, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value.* See, for example, Specification, pg. 9, lines 24-28; pg. 10, lines 23-27; pg. 17, lines 27-28; pg. 19, lines 8-14; pg. 20, lines 10-

.12; pg. 20, lines 20-23; pg. 21, lines 13-17; pg. 21, lines 29-31; pg. 22, lines 13-21; pg. 22, lines 23-25; pg. 24, line 24 to pg. 25, line 5; pg. 26, lines 11-20; pg. 27, lines 3-4; pg. 27, lines 12-15; pg. 27, lines 19-27; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 31, lines 6-8; pg. 32, lines 16-18; pg. 34, lines 4-6; pg. 34, lines 18-22; pg. 34, lines 30-32; pg. 36, lines 12-17; FIG. 1, reference numeral 106; FIG. 8 and FIG. 9; and FIG. 11, reference numeral 1108.

12. Independent Claim 98

In accordance with one or more embodiments, a method for changing a value of a gaming token provides for *associating a first non-zero value with a gaming token*. See, for example, Specification, pg. 8, line 23 to pg. 9, line 3; pg. 10, lines 23-27; pg. 20, lines 15-17; pg. 22, line 27 to pg. 23, line 4; pg. 29, lines 6-8; pg. 29, lines 31-32; pg. 32, lines 22-25; pg. 33, lines 5-8; FIG. 1, reference numeral 102; FIG. 8 and FIG. 9; FIG. 11, reference numeral 1102; and FIG. 13 – FIG. 22.

The method further provides for *determining that a gaming token has been taken out of a room by a player*. See, for example, Specification, pg. 23, line 31 to pg. 24, line 2; and FIG. 10, reference numeral 1012.

The method further provides for, *in response to determining that the gaming token has been taken out of a room by the player, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value*. See, for example, Specification, pg. 9, lines 24-28; pg. 10, lines 23-27; pg. 17, lines 27-28; pg. 19, lines 8-14; pg. 20, lines 10-12; pg. 20, lines 20-23; pg. 21, lines 13-17; pg. 21, lines 29-31; pg. 22, lines 13-21; pg. 22, lines 23-25; pg. 24, line 24 to pg. 25, line 5; pg. 26, lines 11-20; pg. 27, lines 3-4; pg. 27, lines 12-15; pg. 27, lines 19-27; pg. 27, lines 29-31; pg. 28, lines 6-11; pg. 29, lines

. 6-8; pg. 29, lines 31-32; pg. 31, lines 6-8; pg. 32, lines 16-18; pg. 34, lines 4-6; pg. 34, lines 18-22; pg. 34, lines 30-32; pg. 36, lines 12-17; FIG. 1, reference numeral 106; FIG. 8 and FIG. 9; and FIG. 11, reference numeral 1108.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims **6-9, 73-85**, and **88** stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention.

Claims **6, 8, 80**, and **92-98** stand rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of

- U.S. Patent No. 6,264,109 of Chapet et al. (“Chapet” herein); and
- U.S. Patent No. 4,926,996 to Eglise et al. (“Eglise” herein).

Claims **73** and **75-78** stand rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of

- Chapet;
- Eglise; and
- U.S. Patent No. 5,361,885 to Modler (“Modler” herein).

Claim **74** stands rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of

- Chapet;
- Eglise;
- Modler; and
- U.S. Patent No. 6,050,487 to Bonifas (“Bonifas” herein).

Claim **79** stands rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of

- Chapet;
- Eglise;
- Modler; and
- U.S. Patent No. 5,706,925 to Orus (“Orus” herein).

Claims **7, 9, 81-82**, and **88** stand rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of

- Chapet;
- Eglise; and
- Bonifas.

Claims **83-85** and **90-91** stand rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of

- Chapet;
- Eglise;
- Bonifas; and
- Orus.

Claim **89** stands rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of

- Chapet;
- Eglise;
- Bonifas; and
- Modler.

ARGUMENTS

1. Summary of Arguments

The rejections fail for various reasons.

- All of the rejections fail for failure to establish a *prima facie* case. The Examiner has not provided any factual findings in support of any rejection, has not provided substantial evidence in support of any rejection. Accordingly, without more and according to law, Appellants are entitled to allowance of the claims.
- The rejections under 35 U.S.C. § 112, second paragraph, are based on (i) improper legal standards, and (ii) improper disregard for the language of the specification and the claims.
- The rejections under 35 U.S.C. §103(a) fail at least because the rejections for obviousness constitute conclusory statements and unsupported allegations, ignore claim limitations, and are completely devoid of any motivation to combine the references. Further, the references do not, alone or in combination, teach all of the limitations of any claim being appealed and do not provide any motivation to combine the references, even if the combination did result in the claimed combination (which it does not).

Accordingly, the rejections are inappropriate and Appellants respectfully request that the rejections be reversed.

2. Form of Appeal Brief

In the arguments herein, limitations of the claims are indicated in *italics*, claim numbers are indicated in **bold**, and the references of record are indicated by underlining.

In separate arguments of patentability of different Groups of claims, Appellants have, where possible, referred to prior arguments to avoid undue repetition.

In the arguments below, Appellants may refer to:

The First Office Action, which was mailed on November 7, 2001 as part of Paper No. 5;

The Second Office Action, which was mailed on September 25, 2002 as part of Paper No. 11;

The Third Office Action, which was mailed on January 2, 2003 as part of Paper No. 13;

The Fourth Office Action, which was mailed on August 5, 2003 as part of Paper No. 17;

The Fifth Office Action, which was mailed on April 6, 2004 as part of Paper No. / Mail Date 20040331; and

The Sixth Office Action, which is the office action the rejections of which are being appealed herein, and which was mailed on January 13, 2005 as part of Paper No. / Mail Date 122404.

3. 35 U.S.C. §112, second paragraph, Rejections

The proper legal standard for indefiniteness was not applied to the rejected claims. Accordingly, the Examiner has not presented a *prima facie* case that any

claim is indefinite. In fact, applying the proper legal standard demonstrates that all claims are properly drafted to comply with both the first and second paragraphs of §112.

3.1. Claims 6-9, 73-85, and 88

Each of independent claims **6-9, 73-85, and 88** is properly drafted to point out and distinctly claim an embodiment of the invention, and none of independent claims **6-9, 73-85, and 88** is lacking an “essential step” as alleged by the Examiner.

3.1.1. Basis for the Rejection

Independent claims of **6-9, 73-85, and 88** stand rejected by the Examiner under 35 U.S.C. §112, second paragraph, “as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.” Sixth Office Action, pg. 2, third paragraph. In particular, the Examiner states that “[t]he claims fail to recite the steps and show how a token, a tangible device, is able to change value.” *Id.*, fourth paragraph.

The first paragraph of MPEP §2172.01 states that a rejection for “a claim which omits matter disclosed to be essential to the invention” is to be made under 35 U.S.C. 112, *first* paragraph, not 35 U.S.C. §112, second paragraph. Accordingly, an “essential elements” rejection is a rejection for lack of enablement of the claimed invention, not indefiniteness. First paragraph of MPEP 2172.01. Given the statement that independent claims **6-9, 73-85, and 88** are “incomplete for omitting essential steps”, Appellants proceed under the assumption that the rejections of independent claims **6-9, 73-85, and 88** are under 35 U.S.C. §112, first paragraph.

. . . Appellants note that a claim which fails to *interrelate* essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. §112, second paragraph, for failure to point out and distinctly claim the invention. Second paragraph of MPEP §2172.01. If the rejections of independent claims **6-9, 73-85, and 88** were intended to be for failure to *interrelate* essential elements, Appellants respectfully request that the Examiner indicate which essential elements of independent claims **6-9, 73-85, and 88** must be *interrelated*.

According to MPEP §2172.01, essential elements are those that must be described by the applicant(s) as necessary to practice the invention. Nowhere has the allegedly essential step of “how the value of the token is being changed” been described as necessary to practice the invention. In other words, any or all of the various ways enabled throughout the specification by which the value of a token may be changed may be utilized to change the value of the token. The Examiner’s confusion may likely stem from the extraordinarily narrow definition of a “token” as defined by the Examiner as simply comprising “a piece of metal”. Sixth Office Action, pg. 2, fourth paragraph. Appellants respectfully note that currently claimed embodiments are in no way limited by this arbitrary definition set forth by the Examiner. In sum, this rejection is appropriate only where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. MPEP §2172(I).

The invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention. MPEP §2172(I). There is no evidence to the contrary, and the Examiner has not alleged any evidence in support of the stated position.

Broad language in the disclosure, including the abstract, omitting an allegedly critical step tends to rebut the argument of criticality. MPEP §2164.08(c).

Applicants note that the present specification as filed does in fact have, in several places, language that omits the allegedly essential step. For example, the abstract, the summary and several claims as filed have language which omits the proposed step of “how the value of the token is being changed”.

An enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of *the specification makes it clear* that the limitation is *critical* for the invention to function as intended. MPEP §2164.08(c) (emphasis added). Applicants also note that features which are merely preferred are not to be considered critical, and thus need not be recited in claims. MPEP §2164.08(c).

4. 35 U.S.C. §103 Rejections

Claims **6, 8, 80, and 92-98** stand rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Chapet and Eglise, claims **73 and 75-78** stand rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Chapet, Eglise, and Modler, claim **74** stands rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Chapet, Eglise, Modler, and Bonifas, claim **79** stands rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Chapet, Eglise, Modler, and Orus, claims **7, 9, 81-82, and 88** stand rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Chapet, Eglise, and Bonifas, claims **83-85** and **90-91** stand rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Chapet, Eglise, Bonifas, Orus, and claim **89** stands rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Chapet, Eglise, Bonifas, and Modler. Appellants traverse these rejections.

A reading of the rejections reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by any evidence of record. Accordingly, the Examiner has not presented a *prima facie* case of obviousness of any claim.

The Examiner's Section 103(a) rejections based on the above grounds are argued separately for the following groups of appealed claims:

- Claims **6, 8, 80, and 92-98**;
- Claim **73** and **75-78**;
- Claim **74**;
- Claim **79**;
- Claims **7, 9, 81-82, and 88**;
- Claims **83-85** and **90-91**; and
- Claim **89**.

4.1. The Proper Legal Standard under 35 U.S.C. § 103(a)

The Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 U.S.P.Q.2D 1780, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an unrebutted *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the

claimed invention, and the level of ordinary skill in the art. *In re Rouffet*. The secondary considerations are also essential components of the obviousness determination. *In re Rouffet*.

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

When a rejection is based on a combination of references, the Examiner can satisfy the *prima facie* burden only by showing some objective teaching leading to the purported combination of references. *In re Fritch*. Lacking a motivation to combine references, there is no *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 5 U.S.P.Q.2d 1596, 837 F.2d 1071 (Fed. Cir. 1988); *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. *Cardiac Pacemakers v. St. Jude Medical*, 381 F.3d 1371, 1376 (Fed. Cir. 2004). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2D 1313, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. *In re Grabiak*, 226 U.S.P.Q. 870, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for the position that the proposed modification would *prima facie* have been obvious. *Id.* The absence of such a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 42 U.S.P.Q.2D 1378, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

When the art in question is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. *McGinley v. Franklin Sports, Inc.*, 60 U.S.P.Q.2D 1001, 262 F.3d 1339, 1352 (Fed. Cir. 2001). In each case the factual inquiry whether to combine references must be thorough and searching. *Id.*, at 1352-53.

Finally, during examination, claims are given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 54 U.S.P.Q.2D 1664, 211 F.3d 1367 (Fed. Cir. 2000). The “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” *In re Morris*, 44 U.S.P.Q.2D 1023, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).

4.2. Substantial evidence is required of all factual findings

In a determination of obviousness, factual findings as to scope and content of the prior art, level of ordinary skill in the art, differences between the claimed

invention and the prior art, and secondary considerations of nonobviousness must be supported by substantial evidence. *Novamedix Distrib. Ltd. v. Dickinson*, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

"[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" *In re Zurko*, 59 U.S.P.Q.2D 1693, 258 F.3d 1379, 1385 (Fed. Cir. 2001); *In re Lee*, 61 U.S.P.Q.2D 1430, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Moreover, where a conclusion of obviousness rests on the prior knowledge in the field of the invention, then that "[p]rior knowledge in the field of the invention must be supported by tangible teachings of reference materials." *Cardiac Pacemakers, Inc. v St. Jude Medical, Inc.*, 381 F.3d 1371 (Fed. Cir. 2004).

4.3. Absent substantial evidence, no *prima facie* case exists

To reject claims in an application under Section 103, an examiner must show an unrebutted *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

The initial burden of presenting a *prima facie* case of obviousness is upon the examiner. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 U.S.P.Q.2D 1955, 9 F.3d 1531, 1532 (Fed. Cir. 1993); *Novamedix Distrib. Ltd. v. Dickinson*, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

4.4. Claims 6, 8, 80, and 92-98

Claims **6, 8, 80, and 92-98** stand rejected under Section 103(a) as being unpatentable over Chapet in view of Eglise. Claims **6, 8, 80, 92-93, 95-96, and 98** are independent. Claim **94** is dependent upon claim **93**, and claim **97** is dependent upon claim **96**.

The rejections of claims **6, 8, 80, and 92-98** are flawed at least because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has at least failed to provide substantial evidence for a motivation to combine or modify the references in the manner suggested.
- The references, alone and in combination, fail to teach the claim limitations of (i) *wherein the detected event is a period of time that a player has played a gaming device*, (ii) *wherein the detected event is a number of times that a player has played a gaming device*, (iii) *wherein the detected event is cashing in of the gaming token*, or (iv) *wherein the detected event is insertion of the gaming token in a gaming device*.

4.4.1. No Prima Facie Showing of Obviousness: Claims 6, 8, 80, and 92-98

A reading of the rejections of claims **6, 8, 80, and 92-98** reveals that the motivation to combine the references provided by the Examiner is not supported by evidence and is not directed to how or why the references would have been combined.

Further, even if the motivation to combine the references was proper and supported by the requisite substantial evidence on the records (which Appellants

maintain it is not), the references, either alone or in combination, fail to teach limitations of claims **6, 8, 80, and 92-98**.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of claims **6, 8, 80, and 92-98**.

4.4.1.1. No Showing that Claim Limitations Are in References

The Examiner has rejected claims **6, 8, 80, and 92-98** as unpatentable over Chapet in view of Eglise. However, the Examiner has not provided any explanation as to what teaching or suggestion in either of these references, alone or in combination, teaches or suggests the following limitations recited by claims **6, 8, 80, and 92-98**:

wherein the detected event is a period of time that a player has played a gaming device (claim 6),

wherein the detected event is a number of times that a player has played a gaming device (claim 8),

wherein the detected event is cashing in of the gaming token (claim 80), or

wherein the detected event is insertion of the gaming token in a gaming device (claims 92-98).

The Examiner has merely provides the conclusory statement that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the featured limitations cited above, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. In re Stevens, 101 USPQ 284 (CCPA 1954).” Sixth Office Action, pg. 4, end of first

paragraph. Appellants are unable to discern how the Examiner believes that any of the above-cited claim limitations are related to *necessary adjustability*, as contemplated by *In Re Stevens* case. The Examiner, for example, utterly fails to provide any explanation or support for this assertion.

In other words, the Examiner states that, although the combination of Chapet and Eglise does not teach or suggest these limitations, that these limitations would have been *obvious modifications* of the Chapet and Eglise combination. In other words, the Examiner admits that these limitations are not taught or suggested by the Chapet and Eglise combination.

It is well settled that “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” MPEP §2143.03.

Appellants have carefully reviewed both references and fail to find any teaching or suggestion that would even remotely suggest the above-quoted limitations of claims **6, 8, 80, and 92-98**.

4.4.1.2. No Motivation to Combine Provided

Regarding motivation to combine, as discussed above, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The motivation provided by the Examiner for combining Chapet and Eglise rests on a two-part thought process:

First, the Examiner attempts to provide a motivation to combine the two references with the following assertion:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the features cited above as taught by Eglise into the Chapet type device in order to reduce the number of coins that players have to carry around.

Sixth Office Action, pg. 4, first paragraph.

Second, the Examiner attempts to provide a further motivation to explain how the combination could be “obviously” modified to teach the claim limitations, based on the following assertion:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the featured limitations cited above, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. In re Stevens, 101 USPQ 284 (CCPA 1954).

Sixth Office Action, pg. 4, end of first paragraph.

Both of these motivations fails for various reasons:

(i) Initially, the Examiner’s first motivation alleging that one would have combined Chapet and Eglise to “reduce the number of coins that players have to carry around” is not tenable. Eglise alone, for example, states that the Eglise invention is directed to alleviating the need to handle and carry a large number of coins. Eglise, Col. 1, lines 60-64. It is not clear, therefore, why anyone would combine Chapet and Eglise to simply achieve the benefits of Eglise alone. In other words, the Examiner’s motivation may describe why one would practice the Eglise invention, but does not address why one would combine Chapet and Eglise to read on the currently claimed embodiments.

. . . (ii) Second, even if there was some motivation or suggestion to combine Chapet and Eglise (which Appellants maintain there is not), the Examiner's second motivation fails to make up for the deficiencies of the combined references. Even though *none* of the above-quoted limitations of claims 6, 8, 80, and 92-98 are taught or suggested by either reference, alone or in combination (at least as evidenced by the absence of an attempt by the Examiner to point to specific teachings of either reference), for example, the Examiner argues that such limitations would be obvious as objects of *necessary adjustability*. It is not clear how such limitations can be deemed *necessary* to practicing either Chapet or Eglise, when no mention of such features can be found in either reference. Further, there is no evidence that such limitations (which provide many advantages, as described throughout Appellants' disclosure) amount to mere *adjustments*. Indeed, the utter lack of contemplation of any of the above-quoted features in either reference appears to indicate that such features are anything but mere adjustments. Appellants assert, for example, that altering the value of a token in response to events described by such limitations is novel and advantageous.

As discussed above with respect to the applicable law, it is the burden of an examiner to provide in the record relevant findings of fact adequate to show *why* one of ordinary skill in the art would have been motivated to modify a reference in a manner proposed by the examiner. This Examiner, however, has not indicated any reasoning for (much less any evidence of) either (1) *why* one of ordinary skill in the art would have looked to Eglise based on the teachings of Chapet, or *vice versa*; or (2) if there is substantial evidence that Eglise is somehow relevant to Chapet (which Appellants dispute), why, of all the subject matter discussed in Eglise, one of ordinary skill in the art would have selected the specific teaching identified by the Examiner to modify the Chapet system.

. . . For example, the Examiner may provide support for the proposed modification by providing substantial evidence about knowledge of one of ordinary skill in the art or by pointing to a statement in the reference that would have prompted the proposed modification. No such findings of fact have been made in support of the rejection of claims **6, 8, 80, and 92-98**. The above-quoted assertions are completely devoid of any reasoning or fact finding as to *why* one of ordinary skill in the art would have been motivated to make the proposed combination or modifications. The Board is not permitted to accept conclusory findings made by the Examiner that are not supported by any evidence of record. *In re Zurko*, 59 U.S.P.Q.2D 1693, 258 F.3d 1379, 1385 (Fed. Cir. 2001); *In re Lee*, 61 U.S.P.Q.2D 1430, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Thus, in summary, the Examiner has not shown a motivation in the record to modify or combine any of the references of record in any manner that renders any of claims **6, 8, 80, and 92-98** obvious.

4.4.1.3. No Showing of Level of Ordinary Skill in the Art

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine either what “would have been obvious matter of design choice at the time the invention was made” or what references would have been analogous.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to claims 6, 8, 80, and 92-98 because the Examiner has not shown (i) that all of the limitations of claims 6, 8, 80, and 92-98 are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders claims 6, 8, 80, and 92-98 obvious. Thus, the Section 103(a) rejections of claims 6, 8, 80, and 92-98 should be reversed.

4.4.2. Any Combination of the References Fails to Teach All of the Limitations of claims 6, 8, 80, and 92-98

Even if the Examiner had established substantial evidence of a motivation to make the proposed combination of Chapet and Eglise (which Appellants dispute above), the proposed combination would fail to teach (i) *wherein the detected event is a period of time that a player has played a gaming device* (claim 6), (ii) *wherein the detected event is a number of times that a player has played a gaming device* (claim 8), (iii) *wherein the detected event is cashing in of the gaming token* (claim 80), or (iv) *wherein the detected event is insertion of the gaming token in a gaming device* (claims 92-98).

Appellants have reviewed each reference and have been unable to find any indication in either reference related to the above-quoted limitations. As described above, the Examiner agrees that none of these limitations can be found in either reference. Neither reference, for example, describes changing the value of a token in response to (i) a period of time a player has played a machine, (ii) a number of times that a player has played a machine, (iii) a cashing-in of the token, or (iv) an insertion of the token into a gaming device. While Eglise does describe a change in

value of an account associated with a player and a player's token, such an action as described by Eglise is not the same as either a "cashing-in" of a token or the insertion of a token into a gaming machine. The change in the value of the player's account does not occur in Eglise, for example, when the token is inserted into the machine or when the token is "cashed-in".

Thus, both Chapet and Eglise, alone and in combination, lack any hint or suggestion of the desirability of changing a value of a token in response to an event (i) *wherein the detected event is a period of time that a player has played a gaming device* (claim 6), (ii) *wherein the detected event is a number of times that a player has played a gaming device* (claim 8), (iii) *wherein the detected event is cashing in of the gaming token* (claim 80), or (iv) *wherein the detected event is insertion of the gaming token in a gaming device* (claims 92-98).

In summary, the Examiner's proposed combination of the references fails to teach the above-mentioned limitation of claims 6, 8, 80, and 92-98. Further, Appellants assert that any other combination of the references of record also fail to teach or suggest the limitation as claimed. Thus, the Section 103(a) rejections of claims 6, 8, 80, and 92-98 should be reversed.

4.5. Claims 73 and 75-78

Claims 73 and 75-78 stand rejected under Section 103(a) as being unpatentable over Chapet and Eglise in view of Modler. Claim 73 is independent, and claims 75-78 depend upon claim 73.

The rejection of claims 73 and 75-78 is flawed at least because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has failed to provide substantial evidence for a motivation to combine or modify the references in the manner suggested; and
- The references, alone and in combination, fail to teach the claim limitation of *in which the gaming token includes a display device mounted in the gaming token, the display device being switchable between a first display status and a second display status different from the first display status.*

4.5.1 *No Prima Facie Showing of Obviousness: Claims 73 and 75-78*

A reading of the rejections of claims 73 and 75-78 reveals that the motivation to combine the references provided by the Examiner is not supported by evidence and is not directed to how or why the references would have been combined.

Further, even if the motivation to combine the references was proper and supported by the requisite substantial evidence on the records (which Appellants maintain it is not), the references, either alone or in combination, fail to teach limitations of claims 73 and 75-78.

Accordingly, the Examiner has not presented a *prima facie* case of obviousness of claims 73 and 75-78.

4.5.1.1. *No Showing that Claim Limitations Are in References*

The Examiner has rejected claims 73 and 75-78 as unpatentable over Chapet and Eglise in view of Modler. The Examiner agrees (Sixth Office Action, pg. 4, last paragraph) that neither Chapet or Eglise teach or suggest the limitation of claims 73 and 75-78:

in which the gaming token includes a display device mounted in the gaming token, the display device being switchable between a first display status and a second display status different from the first display status.

The Examiner further states that, although Modler does not teach or suggest this limitation, that the limitation would have been an *obvious modification* of Modler. Sixth Office Action, pg. 5, first paragraph. In other words, the Examiner admits that the limitation is not taught or suggested by Modler.

It is well settled that “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” MPEP §2143.03. Appellants have carefully reviewed all of the references and fail to find any teaching or suggestion that would even remotely suggest the above-quoted limitations of claims 73 and 75-78.

4.5.1.2. No Motivation to Combine Provided

The only motivation for combining Chapet with Eglise that the Examiner has provided is the one discussed above in Section 4.4.1.1. This motivation fails at least for the reasons presented in Section 4.4.1.1, which will not be repeated here, for purposes of brevity.

The Examiner further contends that modifying the engraved token value of Modler to comprise a display device switchable between different status displays involves merely the replacement of a mechanical means by an automatic means, which the Examiner states has been held to comprise “only routine skill in the art.”

Sixth Office Action, pg. 5, first paragraph. The Examiner has not even attempted to indicate any motivation to provide specifically for such a feature, much less provide substantial evidence of any such motivation. Nor is there any support for the contention that a display device on a token is in any way a mere replacement of a mechanical means by an automatic means. There is not even support for the contention that the engraved value described in Modler is a “mechanical means”.

The Section 103 rejections of claims **73** and **75-78** fail for at least these reasons.

4.5.1.3. No Showing of Level of Ordinary Skill in the Art

As discussed above in Section 4.4.1.2, the Examiner has failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Appellants asseverate that the Examiner is unable to determine what “would have been obvious matter of design choice at the time the invention was made.”

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to claims **73** and **75-78** at least because the Examiner has not shown (i) that all of the limitations of claims **73** and **75-78** are taught by the references of record, alone or in combination; nor (ii) a motivation in the prior art of record to combine the references in any manner that renders claims **73** and **75-78** obvious. Thus, the Section 103(a) rejections of claims **73** and **75-78** should be reversed.

4.5.2. Any Combination of the References Fails to Teach All of the Limitations of claims 73 and 75-78

Even if the Examiner had established substantial evidence of a motivation to make the proposed combination of Chapet, Eglise, and Modler (which Appellants dispute above), the proposed combination would fail to teach *in which the gaming token includes a display device mounted in the gaming token, the display device being switchable between a first display status and a second display status different from the first display status.*

None of the references describe a display device mounted in the gaming token. As described above, the Examiner agrees that none of the references teach such a limitation. The engraved value on the face of the token in Modler, for example, is not a display device mounted in the gaming token, it is simply an engraving on the token's surface. The Examiner does not contend otherwise.

Thus, all of Chapet, Eglise, and Modler, alone and in combination, lack any hint or suggestion of the desirability of *in which the gaming token includes a display device mounted in the gaming token, the display device being switchable between a first display status and a second display status different from the first display status.*

In summary, the Examiner's proposed combination of the references fails to teach the above-mentioned limitation of claims 73 and 75-78. Further, Appellants assert that any other combination of the references of record also fail to teach or suggest the limitation as claimed. Thus, the Section 103(a) rejections of claims 73 and 75-78 should be reversed.

4.6. Claim 74

Claim 74 stands rejected under Section 103(a) as being unpatentable over Chapet, Eglise, and Modler in view of Bonifas. Claim 74 is dependent upon claim 73 and is believed patentable at least for depending upon a patentable base claim (as described in 4.5 above).

The rejection of claim 74 is further flawed because the Examiner has not made a *prima facie* case of obviousness, at least for the reasons presented in Sections 4.4. and 4.5., above. Those reasons are not reproduced here, for brevity.

Appellants also note, however, that the Examiner has neither pointed to a specific motivation to combine any of Chapet and Eglise, Chapet and Modler, Chapet and Bonifas, Eglise and Modler, Eglise and Bonifas, or Modler and Bonifas, nor supported any such motivations with substantial evidence on the record.

Further, Bonifas simply fails to make up for the deficiencies of any or all of Chapet, Eglise, and Modler. Bonifas, for example, describes different colored tokens, which is indeed common. A colored token is simply not the same, however, as a token that comprises a display device capable of displaying different colors to represent different statuses of a token (as recited in claim 74). Indeed, the colors of Bonifas are fixed (*e.g.*, once a token is colored, it is not easily, if at all, re-colorable) and are not capable of indicating different statuses of a single token.

At least for these reasons, the Section 103(a) rejection of claim 74 should be reversed.

4.7. Claim 79

Claim 79 stands rejected under Section 103(a) as being unpatentable over Chapet, Eglise, and Modler in view of Orus. Claim 79 is independent.

The rejection of claim 79 is further flawed because the Examiner has not made a *prima facie* case of obviousness, at least for the reasons presented in Section 4.4., above. Those reasons are not reproduced here, for brevity.

Appellants also note, however, that the Examiner has neither pointed to a specific motivation to combine any of Chapet and Eglise, Chapet and Modler, Chapet and Orus, Eglise and Modler, Eglise and Orus, or Modler and Orus, nor supported any such motivations with substantial evidence on the record.

Further, Orus simply fails to make up for the deficiencies of any or all of Chapet, Eglise, and Modler. Orus, for example, describes metallic portions of a token that may allow tokens to “clink” together to produce a sound (*e.g.*, a “clink”). This alleged “sound emitting device” of Orus, however, in no way indicates a status of the token, as recited in claim 79. Nor does the Examiner allege that Orus teaches a sound-emitting device of a token to indicate the status of the token, effectively ignoring limitations of claim 79.

At least for these reasons, the Section 103(a) rejection of claim 79 should be reversed.

4.8. Claims 7, 9, 81-82, and 88

Claims 7, 9, 81-82, and 88 stand rejected under Section 103(a) as being unpatentable over Chapet and Eglise in view of Bonifas. Claims 81 and 88 are independent. Claim 7 is dependent upon claim 6, claim 9 is dependent upon claim 8, and claim 82 is dependent upon claim 81. Each of dependent claims 7, 9, and 82

is believed patentable at least for depending upon a patentable base claim (*e.g.*, as described in 4.4. above as well as in this section).

The rejections of claims **7, 9, 81-82, and 88** are flawed because the Examiner has not made a *prima facie* case of obviousness, at least for the reasons presented in Section 4.4., above. Those reasons are not reproduced here, for brevity.

Appellants also note, however, that the Examiner has neither pointed to a specific motivation to combine any of Chapet and Eglise, Chapet and Bonifas, or Eglise and Bonifas, nor supported any such motivations with substantial evidence on the record.

Further, Bonifas simply fails to make up for the deficiencies of both Chapet and Eglise. Bonifas, for example, does describe an identifier for the “chip card” described in Bonifas, but nowhere does Bonifas describe utilizing that identifier to determine that a prize has been won (as generally recited in claims **81-82** and **88**). The section of Bonifas cited by the Examiner is entirely devoid of any teaching or suggestion related to such a limitation. Nor have Appellants been able to find such a teaching or suggestion in any other portion of Bonifas.

At least for these reasons, the Section 103(a) rejections of claims **7, 9, 81-82, and 88** should be reversed.

4.9. Claims 83-85 and 90-91

Claims **83-85** and **90-91** stand rejected under Section 103(a) as being unpatentable over Chapet, Eglise, and Bonifas in view of Orus. Claims **83-85** are dependent on claim **81** and claims **90-91** are dependent on claim **88**.

The rejections of claims **83-85** and **90-91** are flawed because the Examiner has not made a *prima facie* case of obviousness, at least for the reasons presented in Sections 4.4. and 4.8., above. Those reasons are not reproduced here, for brevity.

Appellants also note, however, that the Examiner has neither pointed to a specific motivation to combine any of Chapet and Eglise, Chapet and Bonifas, Chapet and Orus, Eglise and Bonifas, Eglise and Orus, or Bonifas and Orus, nor supported any such motivation with substantial evidence on the record.

Further, Orus simply fails to make up for the deficiencies of all of Chapet, Eglise, and Bonifas. Contrary to the Examiner's assertions, for example, Orus does not describe transmitting signals via wireless communications from the gaming token or optically scanning the gaming token (*e.g.*, as recited by claims **83-85** and **90-91**). The sections of Orus cited by the Examiner describe electromagnetic presence detection of a token, not transmitting signals. The very nature of electromagnetic presence detection is passive, for example, while transmitting a signal is an active step. Nor does Orus describe optical scanning.

Further, the Examiner's Official Notice regarding bingo and drawings is both misplaced and not supported by any evidence on the record. No reference cited by the Examiner, for example, contemplates a bingo game or a drawing based on tokens as described in currently claimed embodiments. Such an embodiment is not the same as a standard bingo game or drawing, and the Examiner ignores the claim limitations that define the novelty of such an embodiment.

At least for these reasons, the Section 103(a) rejections of claims **83-85** and **90-91** should be reversed.

4.10. Claim 89

Claim 89 stands rejected under Section 103(a) as being unpatentable over Chapet, Eglise, and Bonifas in view of Modler. Claim 89 is dependent upon claim 88, and is believed patentable at least for depending upon a patentable base claim.

The rejection of claim 89 is flawed because the Examiner has not made a *prima facie* case of obviousness, at least for the reasons presented in Sections 4.4. and 4.8., above. Those reasons are not reproduced here, for brevity.

Appellants also note, however, that the Examiner has neither pointed to a specific motivation to combine any of Chapet and Eglise, Chapet and Bonifas, Chapet and Modler, Eglise and Bonifas, Eglise and Modler, or Bonifas and Modler, nor supported any such motivation with substantial evidence on the record. The Examiner's stated motivation "to avoid confusion of the status of the gaming token", Sixth Office Action, pg. 9, first paragraph, for example, does not address why one would have combined the specific teachings of Modler with Bonifas, of Modler with Eglise, of Bonifas with Eglise, and so on. Nor is there any indication that the alleged problem of "avoiding confusion" was apparent at the time of invention, how such a problem would have become apparent to one trying to practice any of the referenced systems, or how such a problem would point to the teachings alleged to be combined by the Examiner. The problem is indeed stated so broadly that one of ordinary skill in the art would not have been likely (even if presented with the problem) to turn to any of the specific teachings cited by the Examiner.

Further, Modler simply fails to make up for the deficiencies of any or all of Chapet, Eglise, and Bonifas. Modler does not, as espoused by the Examiner for

example, show or describe the use of alphanumeric information via a display device. Modler simply shows a standard numeric value etched onto a token.

At least for these reasons, the Section 103(a) rejection of claim **89** should be reversed.

CONCLUSION

Thus, the Examiner's rejections of the pending claims are improper at least because the Examiner has not provided a proper legal basis for rejecting any claim. Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Carson C.K. Fincham using the information provided below.

Appellants hereby request any extension of time that may be required to make this Appeal Brief timely. Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

November 15, 2005
Date



Carson C.K. Fincham
Attorney for Applicants
Registration No. 54,096
Walker Digital, LLC
(203) 461-7041 /direct
(203) 461-7300 /fax
cfincham@walkerdigital.com

APPENDIX A - CLAIMS INVOLVED IN THE APPEAL

6. A method of changing a value of a gaming token, the method comprising:
associating a first non-zero value with a gaming token;
detecting an event; and
in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value,
wherein the detected event is a period of time that a player has played a gaming device.
7. The method of claim 6, wherein the gaming device is a slot machine.
8. A method of changing a value of a gaming token, the method comprising:
associating a first non-zero value with a gaming token;
detecting an event; and
in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value,
wherein the detected event is a number of times that a player has played a gaming device.
9. The method of claim 8, wherein the gaming device is a slot machine.
73. A method of changing a value of a gaming token, the method comprising:
associating a first non-zero value with a gaming token;

. . . detecting an event; and
in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value,

in which the gaming token includes a display device mounted in the gaming token, the display device being switchable between a first display status and a second display status different from the first display status.

74. The method of claim 73, in which the display device displays a first color in the first display status and displays a second color, different from the first color, in the second display status.

75. The method of claim 73, in which the display device is blank in the first display status and displays an alphanumeric readout in the second display status.

76. The method of claim 73, in which the display device displays a first alphanumeric readout in the first display status and displays a second alphanumeric readout, different from the first alphanumeric readout, in the second display status.

77. The method of claim 73, in which the display device includes a light-emitting diode.

78. The method of claim 73, in which the display device includes a liquid crystal display.

79. A method of changing a value of a gaming token, the method comprising:

- . associating a first non-zero value with a gaming token;
detecting an event; and
in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value,
in which the gaming token includes a sound emitting device, mounted in the gaming token, for emitting at least one sound indicative of a status of the gaming token.
- 80. A method of changing a value of a gaming token, the method comprising:
associating a first non-zero value with a gaming token;
detecting an event; and
in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value,
wherein the detected event is cashing in of the gaming token.
- 81. A method of changing a value of a gaming token, the method comprising:
associating a first non-zero value with a gaming token;
detecting an event; and
in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value;
receiving the gaming token at a gaming device;
after said receiving step, reading from the gaming token a token identifier;

· determining on the basis of the read token identifier whether a prize has been won; and
· displaying a result of the determining step.

82. The method of claim 81, in which the gaming device is a slot machine.
83. The method of claim 81, in which reading comprises:
receiving a signal transmitted from the gaming token.
84. The method of claim 81, in which reading comprises:
receiving a signal transmitted via wireless communication from the gaming token.
85. The method of claim 81, in which reading comprises:
optically scanning the gaming token.
88. A method of changing a value of a gaming token, the method comprising:
associating a first non-zero value with a gaming token;
detecting an event; and
in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value,
in which the gaming token includes a display, and
further comprising:
using the display to display information; and

· · · determining an outcome of a game based on the displayed information.

89. The method of claim 88, in which the displayed information is alphanumeric information.

90. The method of claim 88, in which the game is bingo.

91. The method of claim 88, in which the game is a drawing.

92. A method comprising:

associating a first non-zero value with a gaming token;

detecting an event; and

in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value,

wherein the detected event is insertion of the gaming token in a gaming device.

93. A method comprising:

associating a first non-zero value with a gaming token;

determining that a player has played at least a predetermined number of plays of a game; and

in response to determining that the player has played at least a predetermined number of plays of the game, associating a second non-zero value

.with the gaming token, the second non-zero value being different from the first non-zero value.

94. The method of claim 93, in which determining that the player has played at least a predetermined number of plays comprises:

determining that the player has played at least the predetermined number of plays within a predetermined period of time.

95. A method comprising:

associating a first non-zero value with a gaming token;

determining that a player has played a game for a predetermined period of time; and

in response to determining that the player has played the game for a predetermined period of time, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value.

96. A method comprising:

associating a first non-zero value with a gaming token;

determining that a player has achieved a predetermined rank of hand at least two times; and

in response to determining that the player has achieved the predetermined rank of hand at least two times, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value.

97. . The method of claim 96, in which determining that the player has achieved the predetermined rank of hand at least two times comprises:

determining that the player has achieved the predetermined rank of hand at least two times within a predetermined period of time.

98. A method comprising:

associating a first non-zero value with a gaming token;

determining that a gaming token has been taken out of a room by a player;

and

in response to determining that the gaming token has been taken out of a room by the player, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value.

APPENDIX B – EVIDENCE

<NONE>

APPENDIX C – RELATED PROCEEDINGS

<NONE>